



14 MAY 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

#6

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Joseph S. Tripoli
THOMSON Multimedia Licensing Inc.
Patent Department
PO Box 5312
Princeton, New Jersey 08540

| | | |
|--------------------------------------|---|----------------------|
| In re Application of BASSET | : | |
| U.S. Application No.: 09/980,389 | : | DECISION ON PETITION |
| Int. Application No.: PCT/FR00/01464 | : | |
| Int. Filing Date: 29 May 2000 | : | UNDER 37 CFR 1.47(b) |
| Priority Date: 02 June 1999 | : | |
| Attorney Docket No.: SCP061817 | : | |
| For: COMMUNICATION INSTALLATION FOR | : | |
| COLLECTIVE DATA RECEPTION | : | |

This is in response to the "PETITION UNDER 37 CFR 1.47 FOR ACCEPTANCE OF APPLICATION WITHOUT PARTICIPATION OF INVENTOR" filed 23 July 2002, which is being treated as a petition under 37 CFR 1.47(b) requesting that the present application be accepted for United States national stage processing without the signature of the sole inventor.

BACKGROUND

On 29 May 2000, applicant filed international application PCT/FR00/01464, which claimed priority of an earlier French application filed 02 June 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 16 December 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 December 2001 (02 December 2001 being a Sunday).

On 29 November 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the requisite basic national fee required by 35 U.S.C. 371(c)(1).

On 11 February 2002, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 23 July 2002, applicant filed the present petition under 37 CFR 1.47(b). The petition was accompanied by, *inter alia*, a petition and fee for a four month extension of time, the surcharge for filing of the oath or declaration beyond thirty months from the priority date, a

declaration executed by Joseph Tripoli for non-signing inventor Jean Claude Basset, copies and translations of e-mail messages to and from Jean Claude Basset, copies and translations of registered letters to Jean Claude Basset, a copy and translation of a contract transferring proprietary rights to Thomson Multimedia Digital France, and a power of attorney to Joseph Tripoli from Thomson Multimedia Digital France.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(I), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that the sole inventor Jean Claude Basset refuses to sign. Exhibit D of the petition indicates that a copy of the application papers were mailed to Mr. Basset on 19

March 2002. Thus, petitioner has demonstrated that a bona fide attempt was made to present a copy of the application papers to Mr. Basset for signature. The petition includes a series of e-mails and registered letters (see exhibits A-D) which request Mr. Basset's signature. The petition effectively indicates that the conclusion that Mr. Basset refuses to execute the application papers is drawn from his failure to return executed copies since none of the e-mails from Mr. Basset specifically indicates his refusal or unwillingness to sign. However, an affidavit or declaration of the facts upon which the conclusion is based has not been provided.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor(s) has been provided. However, the declaration is **not** acceptable because it does not comply with 37 CFR 1.497(b) which requires that the declaration state the relationship of the person making the declaration to the inventor. Furthermore, MPEP 324 states that when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

In the present case, although the petition states that a chain of title is established by Exhibit E, such exhibit is insufficient. Specifically, while Exhibit E adequately demonstrates an assignment from Dassault Automatismes et Telecommunications S. A. to Thomson Multimedia Digital France on the French priority application and any subsequent foreign filings based thereon, petitioner has not provided sufficient evidence of assignment or chain of title from Jean Claude Basset to Dassault Automatismes et Telecommunications S. A (DAT). While Exhibit B (10 January 2001 e-mail from Mr. Basset) appears to contain an admission by the inventor that he does not own the invention, it does not establish that DAT was the assignee.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

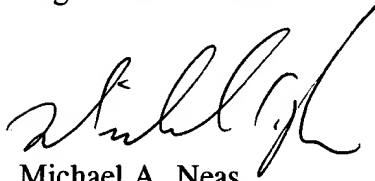
As discussed above, petitioner has not established that the invention has been assigned from the inventor to the 37 CFR 1.47(b) applicant.

CONCLUSION

Because petitioner has not satisfied items (2), (4) and (5) above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time are available under 37 CFR 1.136.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Michael A. Neas
PCT Special Program Examiner
Office of PCT Legal Administration



Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: (703) 308-0954
Facsimile: (703) 308-6459